

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



TRANSMITTAL FORM

(To be used for all correspondence after initial filing)

Total Number of Pages in This Submission

3

Application Number

09/033,832

Filing Date

March 3, 1998

First Named Inventor

Walter W. Mosher, Jr.

Art Unit

3611

Examiner Name

Joanne Silbermann

Attorney Docket Number

PREDDYN-42891

ENCLOSURES (Check all that apply)

☐

Fee Transmittal Form

☐

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☐

Information Disclosure Statement

☐

Certified Copy of Priority Document(s)

☐Reply to Missing Parts/
Incomplete Application☐Reply to Missing Parts
under 37 CFR 1.52 or 1.53☐

Drawing(s)

☐

Licensing-related Papers

☐

Petition

☐Petition to Convert to a
Provisional Application☐

Power of Attorney, Revocation

☐

Change of Correspondence Address

☐

Terminal Disclaimer

☐

Request for Refund

☐

CD, Number of CD(s) _____

☐ Landscape Table on CD☐

After Allowance Communication to TC

☒Appeal Communication to Board
of Appeals and Interferences☐Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)☐

Proprietary Information

☐

Status Letter

☐Other Enclosure(s) (please identify
below):

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

KELLY LOWRY & KELLEY, LLP

Signature

Printed name

Scott W. Kelley

Date

May 22, 2007

Reg. No.

30,762

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name

Scott W. Kelley

Date

May 22, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 22, 2007.



By:

Scott W. Kelley, Reg. No. 30,762

May 22, 2007

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

WALTER W. MOSHER, JR.

Serial No. 09/033,832

Filed: March 3, 1998

FOR: IDENTIFICATION DEVICE
HAVING REUSABLE
TRANSPONDER

Group Art Unit: 3611

Examiner: Joanne Silbermann

Our Docket No. PREDYN-42891

REPLY APPEAL BRIEF

MS: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Gentlemen:

Applicant hereby submits its Reply Brief in connection with the above-identified application, and further to its Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences, filed May 30, 2006.

PREDYN-42891
Serial No. 09/033,832
REPLY BRIEF

ARGUMENT

Contrary to the arguments set forth in the Examiner's Answer, Tokunaga teaches permanent affixation of the antenna to the connector in the casing. As cited in applicant's main Brief, the Tokunaga reference teaches away from a removable antenna. Tokunaga mentions once that the wristband is removably attached to the casing but never mentions that the antenna is removably attached to the connector.

Throughout the specification, Tokunaga describes the connection terminal of the antenna and the connector in the casing as being attached to form a single unit. In nearly every case this attachment is described as a permanent connection using caulking, welding, metal injection molding, soldering, etc. These "permanent securing process[es]" are in sharp contrast to the Examiner's contention that Tokunaga teaches a removable antenna.

In support of the position that Tokunaga teaches a removable antenna, the Examiner refers to the claim language in Tokunaga. In dependent claim 2, Tokunaga describes the connection terminal as being constructed so that it attaches to and "detaches" from the casing by means of a fixing member, i.e., a screw. Independent claim 5 discusses connectors having a first portion mounted in the casing and a second portion that "detachably receives" the connection terminal.

Apart from these two claims there is no mention in the Tokunaga patent that the antenna is removably connected to the device. This claim language comes without explanation or enablement as to how to practice such removable feature. This is in contrast to the multiple and in-depth explanations of permanent attachment between the connection terminal and connector as cited in applicant's main Brief. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230; USPQ 416, 419 (Fed.Cir. 1986). ("It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of all other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art"), citing, *In re Wesslau*, 353 F.2d 283, 284, 147 USPQ 391, 393 (CCPA 1965). As described above and in applicant's main brief, the specification in Tokunaga only describes how to permanently connect the antenna to the device. It is improper to not

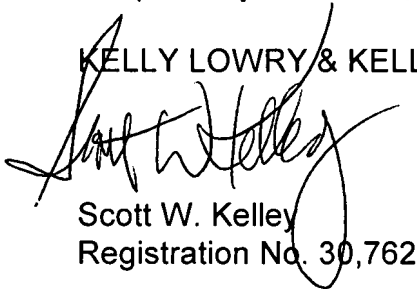
consider a reference in its entirety thereby ignoring those portions of the reference that argue against obviousness. Id at 420.

In addition, a person looking to practice applicant's invention would not have looked to Tokunaga. The connection between the wristband and the casing in Tokunaga is such that it would require the connection to be made prior to attaching the device to a person. The screws which Tokunaga identify as attaching the antenna to the casing are attached from the underside of the casing and could not be inserted after the wristband were placed on a person's wrist. Moreover, the casing in Tokunaga is not even a securement means as set forth in the claims. The casing in Tokunaga is simply that, a casing, as in a digital watch casing. The similarity to a digital watch casing can be clearly seen by looking at Figure 1 of Tokunaga. Tokunaga does not even show a securement means. It is inferred from Tokunaga that the securement means is a buckle as is commonly used on most digital watches today. That securement means in Tokunaga does not operate in any way to connect the antenna to the casing.

For the above reasons and the reasons stated in applicant's initial Brief, applicant requests that the rejection of claims 30, 32, 35-38, 41, 43 and 44 be withdrawn. Applicant submits that the claims are in condition for allowance, notice of which is respectfully requested.

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP



Scott W. Kelley
Registration No. 30,762

SWK:nh
(Submitted in Triplicate)
6320 Canoga Avenue, Suite 1650
Woodland Hills, CA 91367
(818) 347-7900